

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Patent Application No. 09/673,738

REMARKS

Reconsideration and allowance of the subject application are respectfully requested.

Upon entry of this Amendment, claims 1 and 3-22 are pending in the application with claims 1 and 3-7 withdrawn from consideration as being directed to a non-elected invention. In response to the Office Action (Paper No. 15), Applicant respectfully submits that the pending claims define patentable subject matter.

I. Preliminary Matters

The Notice of Acceptance of Application under 35 U.S.C. § 371 and 37 C.F.R. § 1.494 or 1.495 dated November 7, 2000 indicates that the International Search Report and the copies of the documents cited therein have been received by the USPTO (i.e., placed in the application file). However, the Examiner has not listed the references in the Notice of References Cited (PTO-892 form) or provided any other indication that the references have been considered.

As set forth in MPEP 609(II), when the Notice of Acceptance of Application under 35 U.S.C. § 371 and 37 C.F.R. § 1.494 or 1.495 indicates that both the International Search Report and the copies of the documents cited therein are present in the national stage file, the Examiner should consider the cited documents and indicate by a statement in the first Office Action that the information has been considered.

To facilitate things, Applicant is providing a Form PTO-1449 listing the references cited in the International Search Report. Applicant respectfully requests the Examiner to initial the

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references listed on the Form PTO-1449 thereby confirming they were considered and will be listed on any patent resulting from this application.

Along with this Amendment, Applicant is submitting a Supplemental Application Data Sheet identifying JP 10-248264 as a prior foreign application from which priority is not claimed since the original declaration filed on October 20, 2000 does not list JP 10-248264 as a prior foreign application.¹

II. Claim rejections based on Marriott

Claims 8-20 are rejected under 35 U.S.C. § 102(e) as being anticipated by Marriott (USP 6,386,253). Claims 21 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Marriott. With regards to independent claim 8, the Examiner maintains that Marriott (Figure 4) discloses the claimed “peripheral protuberant portion” via the ridge 5 formed at the outer edge surface of the block 1.

By this Amendment, Applicant has amended claim 8 to recite “a peripheral protuberant portion is formed on a tread surface of each block in the vicinity of an end edge thereof so that the height of the block gradually and continuously decreases from a top of the peripheral protuberant portion to the block end edge and from the top of the peripheral protuberant portion to a maximum depth portion in a central region of the block”. Applicant respectfully submits

¹ The present application does not claim priority from JP 10-248264 because JP 10-248264 was filed more than one year before the filing date of the present application (i.e., JP 10-248264 was filed on September 2, 1998 while the present application (PCT Application No. PCT/JP00/00994) was filed on February 22, 2000).

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Marriott does not teach or suggest this feature of the claimed invention. In particular, Applicant respectfully submits that it is quite clear that the ridges 5 (in combination with grooves 4A and 4C) of Marriott are not formed so that the height of the block gradually and continuously decreases from the top of the peripheral protuberant portion to a maximum depth portion in a central region of the block. Rather, Marriott (Figures 3 and 4) simply teaches that the block may have one or more small grooves extending across the block surface.

Accordingly, Applicant respectfully submits that the claimed invention would not have been anticipated by or rendered obvious in view of Marriott because the cited reference does not teach or suggest all of the features of the claims.

III. Claim rejections based on JP '810 and JP '111

Claims 8-11, 14 and 16-19 are rejected under 35 U.S.C. § 102(b) as being anticipated by JP 8-332810 (hereafter "JP '810"). Claims 8-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP '810 in view of JP 7-257111 (hereafter "JP '111").

The rejections in view of JP '810 and JP '111 appear to be predicated on the Examiner's broad reading of claim 8 as not precluding a plurality of relatively small ribs (protuberant portions) arranged over the entire top surface of the block, as shown in Figures 6a-6c of JP '810 and Figures 3a-3f of JP '111 (see page 5 of the Office Action). However, Applicant respectfully submits that the amended claim language of claim 8 precludes the claim from reading on a block having the plurality of small ribs arranged over the entire top surface of the block as disclosed by JP '810 and JP '111.

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Amended claim 8 recites “a peripheral protuberant portion is formed on a tread surface of each block in the vicinity of an end edge thereof so that the height of the block gradually and continuously decreases from a top of the peripheral protuberant portion to the block end edge and from the top of the peripheral protuberant portion to a maximum depth portion in a central region of the block”.

JP ‘810 discloses a plurality of “fine irregularities” provided on the surface of each block for the purpose of breaking water films on a frozen road. Similarly, JP ‘111 discloses forming a plurality of “roughness” shapes 3a-3f over the whole periphery of the tire ground contact surface to achieve more tractive force or braking force on snowy or icy roads. Applicant respectfully submits that the block structures of the claimed invention and the cited references are different not only in structure (the unique sloped configuration vs. simple notches and roughness shapes) but also in function thereof (breaking water films and forming rough area for traction vs. equalizing the ground contact pressure).

Accordingly, Applicant respectfully submits that claims 8-19 should be allowable over JP ‘810 and JP ‘111 because the applied references, alone or combined, do not teach or suggest all of the features of the claims.

IV. Claim rejections based on Kamegawa, EP ‘403 and Miyazaki

Claims 8-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kamegawa et al. (USP 5,503,208; hereafter “Kamegawa”) in view of EP 875403 (hereafter “EP ‘403”).

Claims 21 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kamegawa in

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view of EP '403 and Miyazaki (USP 6,138,728). Applicant respectfully submits that the claimed invention would not have been rendered obvious in view of Kamegawa, EP '403 and Miyazaki because one of ordinary skill in the art would not have been motivated to combine and modify the teachings of the applied references to produce the claimed invention.

The Examiner maintains that “[i]n order to address the problem of high ground contact pressure at the center of a block, Kamegawa decreases the block height toward the center.” The Examiner further maintains that “[i]n order to address the problem of high ground contact pressure at the edge of the block, Europe '403 chamfers the block edge - i.e., decreases the block height toward the block edge.” The Examiner further asserts that “[o]ne of ordinary skill in the art would have been motivated to combine these two teachings to address the problem of high ground contact pressure at the block center and the block edge in order to further improve uniformizing of ground contact pressure - only expected results being obtained.” Applicant respectfully disagrees with the Examiner’s position.

Kamegawa only concentrates on reducing the ground contact pressure at the center portion of a land portion, so that the ground contact property at an edge portion of the land portion is improved. All the cross-section structures illustrated by the figures of Kamegawa clearly show this critical feature of Kamegawa, in which the ground contact pressure is made relatively high in the vicinity of an edge portion of a land portion, as compared with a center portion of the land portion. Specifically, Kamegawa attempts to improve the ground contact property at an edge portion of the land portion, in particular, by relatively increasing the ground

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contact pressure at the edge portion of the land portion, while relatively decreasing the ground contact pressure at the center portion thereof.

On the contrary, EP '403 attempts to improve the ground contact property at a center portion of a land portion, in particular, by relatively decreasing the ground contact pressure at an edge portion of the land portion by chamfering the edge portion, while thus relatively increasing the ground contact pressure at a center portion of the land portion.

In short, the object of the Kamegawa is to improve the ground contact property at an edge portion of the land portion, whereas the object of EP '403 is to improve the ground contact property at a center portion of a land portion. Further, Kamegawa and EP '403 attempt to achieve their respective objects by completely different (opposite) approaches, as described above.

Therefore, Applicant respectfully submits that to the extent that Kamegawa and EP '403 are contradictory with each other, one skilled in the art would not have been motivated to modify Kamegawa based on the teachings of EP '403 in order to produce the claimed invention. Moreover, Applicant submits that the Examiner's conclusions to the contrary could be based only on impermissible hindsight in construing the references as he has to yield the present invention. The Court of Appeals for the Federal Circuit, and the Board of Patent Appeals and Interferences, have held repeatedly that such an approach is inappropriate for determining the obviousness of a claimed invention. See, e.g., In re Geiger, 815 F.2d 686, 2 U.S.P.Q.2d 1276 (Fed. Cir. 1987); Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987); In re Piasecki, 745 F.2d 1468, 223 U.S.P.Q. 785 (Fed. Cir. 1984); In re Gordon, 221

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U.S.P.Q. 1125 (Fed. Cir. 1984); Ex parte Clapp, 227 U.S.P.Q. 972 (Pat. Off. Bd. App. and Inter. 1985); Ex parte Shepard and Gushue, 188 U.S.P.Q. 537 (Pat. Off. Bd. App. 1974).

Accordingly, Applicant respectfully submits that claims 8-22 should be allowable over Kamegawa, EP '403 and Miyazaki because one of ordinary skill in the art would not have been motivated to combine and modify the teachings of the applied references to produce the claimed invention.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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